

529 Rec'd PCT/PTO 16 MAY 2000
PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	PATENT .	#6/IDS
Goran HOLMSTROM et al.)	Group: To Be Assigned	<i>Hawkins</i>
Serial No.: 09/355,729)	Examiner: To Be Assigned	8/4
Filed: August 3, 1999)		
A ROTATING ELECTRIC MACHINE)		
AND METHOD OF MANUFACTURING)		
SUCH A MACHINE)		

* * * * *

INFORMATION DISCLOSURE STATEMENT
SUBMITTED WITHOUT COPIES OF INFORMATION DISCLOSURE
STATEMENT CITATIONS PURSUANT TO DECISION ON PETITION
UNDER 37 C.F.R. 1.183 SEEKING WAIVER OF REQUIREMENTS
UNDER 37 C.F.R. 1.98

Washington, D.C.
May 16, 2000Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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Pursuant to 37 C.F.R. §1.56, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO Form-1449. Copies of the references were filed in the office of Examiner Gellner with a Petition dated September 27, 1999.

The above information is presented so that the Patent and Trademark Office may, in the first instance, determine any materiality thereof to the claimed invention. See 37 C.F.R. §§1.104(a) and 1.106(b) concerning the PTO duty to consider and use any such information. It is

respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

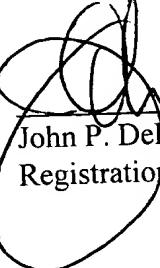
Pursuant to the Decision on Petition dated December 1, 1999, which was filed in U.S. Patent Application No. 09/147,325 (the holding application), the requirement for the submission of a copy of each Information Disclosure Statement citation is waived provided that the conditions set forth in paragraphs 1-8 (pages 8-10) of the Decision on Petition are met.

The conditions set forth in the Decision on Petition are believed to have been met as follows:

1. Three paper copies of each Information Disclosure Statement citation were supplied to the U.S. Patent and Trademark Office on September 29, 1999 with the filing of the Petition.
2. This application (the bulk filing application) for which the waiver is desired is related to the above-identified holding application, U.S. Patent Application No. 09/147,325.
3. The information herein has been cited in the above holding application.
4. A copy of the Decision on Petition granting the waiver is attached hereto.
5. At present, no explanatory information related to any particular citation has been submitted in the holding application except for translations of foreign language references, which were supplied to the office pursuant to paragraph 1 above.
6. As of the time of this filing, the office has not terminated the waiver grant, nor has the applicant terminated or withdrawn its assent to the waiver.
7. The holding application is co-pending herewith.
8. The paper copies of the references cited herein are believed to be contained in a series of official digests established by the Office which is noted in the Decision on Petition.

If additional fees are required, please charge Deposit Account No. 23-0575.

Respectfully submitted,


John P. DeLuca
Registration No. 25,505

WATSON COLE GRINDLE WATSON, P.L.L.C.
1400 K Street, NW, 10th Floor
Washington, D.C. 20005-2477
(202) 628-3600
JPD/er

INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-9
(Corrected Listing of Original List)

Docket Number:
705/71953-2

Application Number
09/355,729

Applicant(s):
Goran HOLMSTROM et al.

Filing Date:
August 3, 1999

Group Art Unit:
To Be Assigned

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1	US1304451	5/20/19	L. H. Burnham			
2	US1418856	6/2/22	Robert B. Williamson			
3	US1481585	1/22/24	James Robert Beard			
4	US1728915	9/24/29	E. P. Blankenship et al			
5	US1742985	1/7/30	L. H. Burnham			
6	US1747507	2/18/30	Robert B. George			
7	US1756672	4/29/30	John M. Barr			
8	US1762775	6/10/30	Albert G. Ganz			
9	US1781308	11/11/30	Mauritz Vos			
10	US1861182	5/31/32	F. Hendey et al			
11	US1974406	9/25/34	Vincent G. Apple et al			
12	US2006170	6/25/35	Gustof A. Juhlin			
13	US2206856	7/2/40	W. E. Shearer			
14	US2217430	10/8/40	R. A. Baudry			
15	US2241832	5/13/41	H.W. Wahlquist			
16	US2251291	8/5/41	L. O. Reichelt			
17	US2256897	9/23/41	W. F. Davidson et al			
18	US2295415	9/8/42	G.R. Monroe			
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20	US2424443	7/22/47	B. C. Evans			
21	US2436306	2/17/48	J. S. Johnson			
22	US2446999	8/17/48	G. Camilli			
23	US2459322	1/18/49	G. T. Johnston			
24	US2462651	2/22/49	H. W. Lord			
25	US2498238	2/21/50	L. J. Berberich et al			
26	US2721905	10/25/55	D. J. Monroe			
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30	US2943242	6/28/60	E. Schaschl et al			
31	US2947957	8/2/60	J. C. Spindler			
32	US2959699	11/8/60	J. W. Smith et al			
33	US2962679	11/29/60	J. L. Stratton			
34	US2975309	3/14/61	M. Seidner			
35	US3098893	7/23/63	R. A. Pringle et al			
36	US3130335	4/21/64	L. J. Rejda			
37	US3143269	8/4/64	J. Van Eldik			
38	US3157806	11/17/64	E. Wiedemann			
39	US3158770	11/24/64	A. D. Coggeshall et al			
40	US3268766	8/23/66	S. E. Amos			
41	US3304599	2/21/67	R. W. Nordin			
42	US3354331	11/21/67	H. L. Broeker et al			
43	US3365657	1/23/68	James Webb			
44	US3372283	5/5/68	A. A. Jaecklin			

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ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

45	US3418530	11/24/68	W. H. Cheever			
46	US3435262	3/25/69	R. B. Bennett et al			
47	US3437858	4/8/69	R. B. White			
48	US3444407	5/13/69	E.S. Yates			
49	US3447002	5/27/69	C. Ronnevig			
50	US3484690	12/16/69	H. Wald			
51	US3560777	2/2/71	W. Moeller			
52	US3593123	7/13/71	A. C. Williamson			
53	US3631519	12/28/71	H. Salahshourian			
54	US3644662	2/22/72	H. Salahshourian			
55	US3651402	3/21/72	P. H. Leffmann			
56	US3670192	6/13/72	A. A. Andersson et al			
57	US3675056	7/4/72	H. G. Lenz			
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59	US3716652	2/13/73	G. E. Lusk et al			
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64	US3758699	9/11/73	G. Lusk et al			
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69	US3809933	5/7/74	H. Sugawara et al			
70	US3881647	5/6/75	B. Wolfe			
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74	US3932779	1/13/76	A. Madsen			
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77	US3947278	3/30/76	K. Youtsey			
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79	US3968388	7/6/76	D. Lambrecht et al			
80	US3971543	7/27/76	W. Shanahan			
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84	US4008409	2/15/77	R. Rhudy et al			
85	US4031310	6/21/77	L. Jachimowicz			
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93	US4091138	5/23/78	Takagi et al			
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(Corrected Listing of Original List)

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	97	US4106069	8/8/78	J. Trautner et al			
	98	US4107092	8/15/78	R. Carnahan et al			
	99	US4109098	8/22/78	M. Olsson et al			
	100	US4121148	10/17/78	H. Platzer			
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	102	US4134055	1/9/79	M. Akamatsu			
	103	US4134146	1/9/79	E. Stetson			
	104	US4149101	4/10/79	A. Lesokhin et al			
	105	US4152615	5/1/79	R. Calfo et al			
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	108	US4164772	8/14/79	N. Hingorani			
	109	US4177397	12/4/79	John Lill			
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	111	US4184186	1/15/80	P. Barkan			
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	133	US4320645	3/23/82	L. Stanley			
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	138	US4347449	8/31/82	J. F. Beau			
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	143	US4367425	1/4/83	M. Mendelsohn et al			
	144	US4368418	1/11/83	F. P. Demello et al			
	145	US4369389	1/18/83	D. Lambrecht			
	146	US4371745	2/1/83	M. Sakashita			

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(Corrected Listing of Original List)

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150	US4411710	10/25/83	M. Mochizuki et al			
151	US4421284	12/20/83	A. Pan			
152	US4425521	1/10/84	G. Rosenberry, Jr. et al			
153	US4426771	1/24/84	D. Wang et al			
154	US4429244	1/31/84	P. Nikiten et al			
155	US4431960	2/14/84	O. Zucker			
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157	US4470884	9/11/84	D. Carr			
158	US4473765	9/25/84	T. Butman, Jr. et al			
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165	US4517471	5/14/85	K. Sachs			
166	US4523249	6/11/85	S. Arimoto			
167	US4538131	8/27/85	M. Baier et al			
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169	US4551780	11/5/85	M. Canay			
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171	US4560896	12/24/85	G. Vogt et al			
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175	US4594630	6/10/86	M. Rabinowitz et al			
176	US4607183	8/19/86	J. Rieber et al			
177	US4615109	10/7/86	M. Wcislo et al			
178	US4618795	10/21/86	G. Cooper et al			
179	US4619040	10/28/86	D. Wang et al			
180	US4633109	12/30/86	J. Feigel			
181	US4650924	3/17/87	J. Kauffman et al			
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183	US4677328	6/30/87	K. Kumakura			
184	US4687882	8/18/87	G. Stone et al			
185	US4692731	9/8/87	H. Osinga			
186	US4723104	2/22/88	F. Rohatyn			
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188	US4745314	5/17/88	J. Nakano			
189	US4766365	8/23/88	L. Bolduc et al			
190	US4785138	11/15/88	O. Brietenbach et al			
191	US4795933	1/3/89	K. Sakai			
192	US4827172	5/2/89	K. Kobayashi			
193	US4845308	7/4/89	E. Womack, Jr. et al			
194	US4847747	7/11/89	A. Abbondanti			
195	US4853565	8/1/89	R. Elton et al			
196	US4859810	8/22/89	R. Cloetens et al			
197	US4860430	8/29/89	H. Raschbichler et al			

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ALTERNATE FORM PTO-1449
 (Corrected Listing of Original List)

	198	US4864266	9/5/89	L. Feather et al			
	199	US4883230	11/28/89	L. Lindstrom			
	200	US4894284	1/16/90	S. Yamanouchi et al			
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	202	US4918347	4/17/90	Y. Takaba			
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	204	US4924342	5/8/90	R. Lee			
	205	US4926079	5/15/90	P. Niemela et al			
	206	US4942326	7/17/90	J. Butler, III et al			
	207	US4949001	8/14/90	S. Campbell			
	208	US4994952	2/19/91	D. Silva et al			
	209	US4997995	3/5/91	M. Simmons et al			
	210	US5012125	4/30/91	D. Conway			
	211	US5036165	7/30/91	R. Elton et al			
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	220	US5111095	5/5/92	J. Hendershot			
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	234	US5325008	6/28/94	J. Grant			
	235	US5327637	7/12/94	O. Britenbach et al			
	236	US5341281	8/23/94	G. Skibinski			
	237	US5343139	8/30/94	L. Gyugyi et al			
	238	US5355046	10/11/94	K. Weigelt			
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	241	US5397513	3/14/95	C. Steketee, Jr.			
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	245	US5500632	3/19/96	J. Halser, III			
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	247	US5530307	6/25/96	G. Horst			
	248	US5545853	8/13/96	N. Hildreth			

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ALTERNATE FORM PTO-1449
 (Corrected Listing of Original List)

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Subtotal:	259						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
1		AT399790	7/25/95	Austria		
2		BE565063	2/23/57	Belgium		
3		CH391071	4/30/65	Switzerland		
4		CH534448	2/28/73	Switzerland		
5		CH539328	7/4/73	Switzerland		
6		CH657482	8/29/86	Switzerland		
7		DD137164	8/15/79	Germany DDR		
8		DD138840	11/21/79	Germany DDR		
9		DE1638176	6/24/71	Germany		
10		DE1807391	5/27/70	Germany		
11		DE2050674	5/19/71	Germany		
12		DE2155371	5/17/73	Germany		
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15		DE2656389	6/15/78	Germany		
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17		DE277012	7/25/14	Germany		
18		DE19547229	6/19/97	Germany		
19		DE2824951	12/20/79	Germany		
20		DE2835386	2/21/80	Germany		
21		DE2839517	3/27/80	Germany		
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25		DE2920478	12/4/80	Germany		
26		DE2939004	4/9/81	Germany		
27		DE3006382	8/27/81	Germany		
28		DE3008818	9/10/81	Germany		
29		DE3009102	9/25/80	Germany		
30		DE3028777	3/26/81	Germany		
31		DE3305225	8/16/84	Germany		
32		DE3309051	9/20/84	Germany		
33		DE336418	6/23/20	Germany		
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	35	DE3543106	6/11/87	Germany		
	36	DE3612112	10/15/87	Germany		
	37	DE372390	3/27/23	Germany		
	38	DE3726346	2/16/89	Germany		
	39	DE387973	1/9/24	Germany		
	40	DE4022476	1/16/92	Germany		
	41	DE4023903	11/7/91	Germany		
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	85	EP0335430	10/4/89	European		

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	34	OD035	Fully slotless turbogenerators; E. Spooner; Proc., IEEE Vol 120 #12, 12/1973
	35	OD036	Toroidal winding geometry for high voltage superconducting alternators; J. Kirtley et al; MIT – Elec. Power Sys. Engrg. Lab for IEEE PES; 2/1974
	36	OD037	High-Voltage Stator Winding Development; D. Albright et al; Proj. Report EL339, Project 1716, April 1984
	37	OD038	POWERFORMER™: A giant step in power plant engineering; Owman et al; CIGRE 1998, Paper 11:1.1
	38	OD039	Thin Type DC/DC Converter using a coreless wire transformer; K. Onda et al; Proc. IEEE Power Electronics Spec. Conf.; 6/1994, pp330-334
	39	OD040	Development of extruded polymer insulated superconducting cable; 1/1992
	40	OD041	Transformer core losses; B. Richardson; Proc. IEEE 5/1986, pp365-368

Examiner

Date
Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

	41	OD042	Cloth-transformer with divided windings and tension annealed amorphous wire; T. Yamamoto et al; IEEE Translation Journal on Magnetics in Japan Vol 4, No. 9 Sept. 1989
	42	OD043	A study of equipment sizes and constraints for a unified power flow controller; J Bian et al; IEEE 1996
Subtotal:	43		

GRAND	671		
TOTAL			

Examiner	Date Considered
*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

INFORMATION DISCLOSURE CITATION LIST ALTERNATE FORM PTO-1449		Docket Number:	Application Number
		Issue 2: dated 02/21/00	
		Applicant(s):	
		Filing Date:	Group Art Unit:

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1		US 4,292,558	9/29/1981	Carl Flick et al			
2		US 4,656,316	4/7/1987	Hans-Juergen Meltsch			
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Examiner	Date Considered
*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449

Issue2: dated 02/21/00

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION
				YES NO
1	GB 1,319,257	6/6/1973	Anders R. Andersson et al	
2	GB 1,322,433	7/4/1973	Siemens Akstiengesellschaft	
3	GB 2,070,341	9/3/1981	Hans-Georg Raschbichler et al	
4	WO 98/20598	5/14/1998	Jan-Anders Karlfeldtsgatan et al	
5	WO 98/20602	5/14/1998	Soren Berggren	
6	WO 98/34239	8/6/1998	Gunnar Steneopsgatan et al	
7	WO 99/28922	6/10/1999	Thorsten Schutte et al	
8	WO 99/29005	6/10/1999	Mats Leijon et al	
9	WO 99/29023	6/10/1999	Peter Carstensen et al	
10	WO 99/29025	6/10/1999	Mats Leijon et al	
11	EP 0056580 A1	7/28/1982	Jacobus F.H. Van der Vegt	
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Subtotal				

Examiner

Date
Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



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OF PATENTS AND TRADEMARKS
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2/3/99

Response to Decision
2-1-00

Paper No. 11

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Oblon Spivak McClelland Maier & Neustadt
1755 Jefferson Davis Highway
Fourth Floor
Arlington VA 22202

In re Application of
Mats Leijon, et al
Application No. 09/147,325
Filed: February 17, 1999
Attorney Docket No. 9847-0001-
6X

: RESPONSE TO PETITION UNDER
: 37 CFR 1.182 SEEKING SPECIAL
: TREATMENT RELATING TO AN
: ELECTRONIC SEARCH TOOL, AND
: DECISION ON PETITION UNDER
: 37 CFR 1.183 SEEKING WAIVER
: OF REQUIREMENTS UNDER 37 CFR
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

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OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT P.C.

- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule¹. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.² In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

- (1) (a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;
- (b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition³ permitting such procedure and a copy of the Form 1449 (or equivalent);⁴ and
- (2) an "electronic search tool"⁵ containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

¹Reference to MPEP 2001.05, Petition, page 3.

²Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

³The original of which would be in the instant holding application.

⁴See, Petition under 37 CFR 1.182, *infra*.

⁵See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.⁶

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

⁶It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty disclosure issues under 37 CFR 1.56, Petition, fn. 5.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the § 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).¹

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

¹It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.⁸ In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,⁹ which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

⁸The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

⁹Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,¹⁰ on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.¹¹

¹⁰Even though the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

¹¹The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following ⁸ conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

preexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,¹² or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case with all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

¹²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

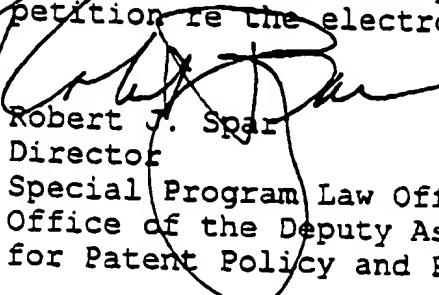
By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Special Program Law Office
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the § 1.182 petition re the electronic search tool.


Robert J. Spair
Director
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachment: List of Digests 13-33

- Digest 13 **HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.)**
- Digest 14 . Having a particular cable application (e.g., winding, etc.)
- Digest 15 .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.)
- Digest 16 .. In a motive power system (e.g., electric motor control system, etc.)
- Digest 17 .. In an electric power conversion, regulation, or protection system
- Digest 18 .. In a power distribution network
- Digest 19 .. In a dynamo-electric machine
- Digest 20 ... Stator
- Digest 21 ... Rotor
- Digest 22 ... Winding, per se
- Digest 23 ... In a circuit breaker, relay, or switch
- Digest 24 ... In an inductive device (e.g., reactor, electromagnet, etc.)
- Digest 25 ... Transformer
- Digest 26 . Having a plural-layer insulation system
- Digest 27 .. Including a semiconductive layer
- Digest 28 ... Plural semiconductive layers
- Digest 29 . Having a semiconductive layer
- Digest 30 . Having insulation with a particular dimension or geometry
- Digest 31 . Having a shield or metallic layer
- Digest 32 . Having means for cooling
- Digest 33 . Method of cable manufacture, assembly, repair, or splicing